

Appl. No. : 10/754,919
Filed : January 10, 2004

REMARKS

A. Introduction

Applicant respectfully requests reconsideration and allowance of this application. Claims 1-28 are pending in the application. Claims 8-19 have been withdrawn from consideration. Applicant has amended Claims 1, 6, 7 and 28. Applicant's claim amendments are shown on the pages above following the heading AMENDMENTS TO THE CLAIMS. On these pages, the deletions are struck through.

Applicant submits that this application is now in condition for allowance, and Applicant earnestly requests such action. Below, Applicant addresses each of the Examiner's rejections.

B. All Claims are Patentable Over Hyodoh

The Examiner rejected Claims 1-7 and 20-28 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0040771A1 to Hyodoh. Applicant respectfully submits that the claims are allowable over Hyodoh.

Claim 1 recites "a temporary absorbable venous occlusive stent, comprising: a stent body; a bio-absorbable material associated with said body; and means for blocking blood flow past said stent."

In order to anticipate a means-plus-function claim limitation, the structure of the prior art must perform the *identical* function specified in the claim. See M.P.E.P. §2183. The monofilament loop shown in FIGS. 12 and 13 of Hyodoh does not perform the function of blocking blood flow as recited in Claim 1. The monofilament loop is part of a retrievable filter and the function of the monofilament loop is to withdraw the filter from the body, as shown below.

After delivery of the filter, the monofilament loop may be led outside the body and secured to the skin. When there is no further need for the filter, it may be withdrawn by pulling it back by the monofilament loop through an advanced sheath.

Hyodoh at p. 33, ¶ 355.

The Examiner takes the position that, "[a]lthough not explicitly stated by Hyodoh, the closed end of the stent *inherently* blocks the flow of blood to some degree." Office Action of Sept. 1, 2005 at p. 2 (emphasis added). Additionally, the Examiner takes the position that "the

stent of Hyodoh would *inherently* perform the function of blocking blood flow, at least to some degree.” Office Action of Sept. 1, 2005 at p. 3 (emphasis added).

“The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” M.P.E.P. §2112 IV. “To establish inherency, the extrinsic evidence must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *Id.*

One of skill in the art would understand that the monofilament loop of the Hyodoh retrievable filter would create a porous, open filter-like end structure even when the monofilament loop is pulled as shown in Figure 13. Thus, as Hyodoh’s disclosure is understood by one of skill in the art, blocking blood flow (or disrupting blood flow to a sufficient degree to be considered “blocking”) does not necessarily occur. This is especially true in view of Hyodoh’s general intention to filter, rather than block, blood flow in the iliac arch, a region where blocking the flow of blood would be quite harmful to the patient. Indeed, Hyodoh emphasizes allowing free blood flow with the cited filter. According to Hyodoh, the Bi-Iliac tube filter shown in FIGS. 11-13 may be “created with a relatively loose mesh allowing the blood to flow freely.” Hyodoh at p. 32, ¶ 350. One skilled in the art would thus read Hyodoh as allowing significant blood flow through the end of the cited filter, even when in the configuration shown in Figure 13.

Accordingly, Applicant respectfully submits that the rejection of Claim 1 should be withdrawn and that Claim 1 should be allowed.

The Examiner does not indicate how Hyodoh anticipates Claim 20. Claim 20 requires “[a] temporary absorbable venous occlusive stent, comprising a stent body comprising: a bio-absorbable material; and an adjustable closure device associated with said stent body, said closure device comprising: an open configuration in which said closure device permits blood flow past said stent body; and a blocking configuration in which said closure device forms a wall that blocks blood flow past said stent body.” The Examiner has not addressed each and every element of Claim 20. For example, the Examiner doesn’t explain, *inter alia*, how the Hyodoh reference discloses an adjustable closure device, the closure device forming a wall in a blocking configuration. Applicant respectfully submits that this and other elements of Claim 20 are not

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disclosed by Hyodoh. Accordingly, Applicant respectfully submits that the rejection of Claim 20 should be withdrawn and that Claim 20 should be allowed.

Dependent Claims 2-7, and 21-28, which include the unique features of either independent Claim 1 or Claim 20, recite additional features of particular advantage and utility. Moreover, Claims 2-7, and 21-28 are allowable for substantially the same reasons presented above with respect to either Claim 1 or Claim 20. Accordingly, Applicant respectfully requests that the Examiner withdraw these rejections. All claims are now in condition for allowance.

C. Conclusion

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, issuance of a Notice of Allowance is most earnestly solicited.

Applicant respectfully traverses each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches. Although amendments and deletions have been made, no acquiescence or estoppel is or should be implied thereby. Rather, the amendments, deletions and cancellations are made only to expedite prosecution of the present application, and without prejudice to presentation or assertion, in the future, of claims on the subject matter affected thereby. Any arguments in support of patentability and based on a portion of a claim should not be taken as founding patentability solely on the portion in question; rather, it is the combination of features or acts recited in a claim which distinguishes it over the prior art.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call the undersigned at (949) 760-0404 to resolve such issue(s) promptly.

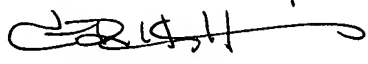
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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11 1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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By: 

Curtis R. Huffmire
Registration No. 48,877
Attorney of Record
Customer No. 20,995
(949) 760-0404

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